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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,580	06/12/2006	Fajun Nan	56816.1740	1738

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EXAMINER
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HAVLIN, ROBERT H

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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04/02/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@bakerlaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,580	<b>Applicant(s)</b> NAN ET AL.	
	<b>Examiner</b> ROBERT HAVLIN	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/15/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

**Status of the claims:** Claims 1-3 and 9-11 are currently pending.

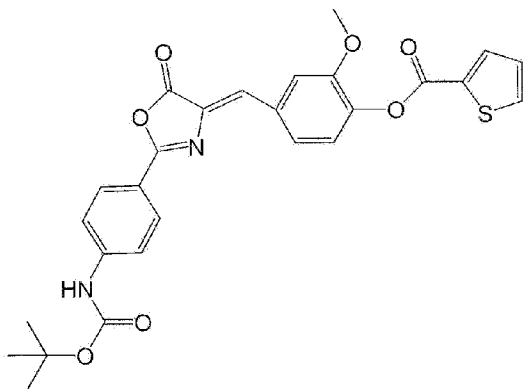
**Priority:** This application is a 371 of PCT/CN03/01115 (12/25/2003) and claims foreign priority to CHINA 200310109331.0 (12/12/2003). Applicant has not filed a certified English translation of the priority document, therefore the priority date is the effective filing date of this application.

**Oath:** Applicant has corrected the defective oath.

**IDS:** The IDS dated 6/15/09 was considered.

### *Election/Restrictions*

1. Applicant's election without traverse of the following species in the reply filed on 2/4/10 is acknowledged.



As detailed in the following rejections, the generic claim encompassing the elected species was not found patentable. Therefore, the provisional election of species is given effect, the examination is restricted to the elected species only, and claims not reading on the elected species are held withdrawn.

Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection through amendment, the amended Markush-type claim will be reexamined to the extent necessary to determine patentability of the Markush-type claim. See MPEP 803.02.

## **RESPONSE TO APPLICANT REMARKS**

### ***Claim Rejections - 35 USC § 102***

2. Claims 1-3 were rejected under 35 U.S.C. 102(b) as being anticipated by Okura et al. (STN abstract of WO 95/06032).

Applicant deleted the alternatives reading on the prior art. Therefore the rejection is **withdrawn**.

### ***Claim Rejections - 35 USC § 103***

3. Claims 4, 6, 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Afifi et al. (Abstract of Revue Roumaine de Chimie (1983), 28(8), 849-55) in view of March (March's Advanced Organic Chemistry, 5<sup>th</sup> ed., (2001) Wiley, 2083 pages).

The claims were cancelled, therefore this rejection is **withdrawn**.

4. Claims 5 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Okura et al. (STN abstract of WO 95/06032) in view of March (March's Advanced Organic Chemistry, 5<sup>th</sup> ed., (2001) Wiley, 2083 pages) and Greene et al. (Protective Groups in Organic Synthesis Greene, 3<sup>rd</sup> ed., New York John Wiley & Sons, Inc., 1999, 779 pages).

The claims were cancelled, therefore this rejection is **withdrawn**.

5. Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Okura et al. (STN abstract of WO 95/06032) in view of Neye et al. (Abstract of Exp Clin Endocrinol Diabetes. 1998;106(4):292-8).

Applicant amended the claims to avoid the prior art, therefore this rejection is **withdrawn**.

### ***Specification***

6. The specification was objected to for containing numerous typographical errors and grammatical problems, for example: the degree symbol is a box throughout and in [0114] the specification reads "the affinities of compounds wang520 and wang516 are little week, ...". Applicant has corrected the specification, thus the objection is **withdrawn**.

7. The specification was objected to for containing numerous typographical errors and grammatical problems, for example: the degree symbol is a box throughout and in [0114] the specification reads "the affinities of compounds wang520 and wang516 are little week, ...". Applicant has corrected the specification, thus the objection is **withdrawn**.

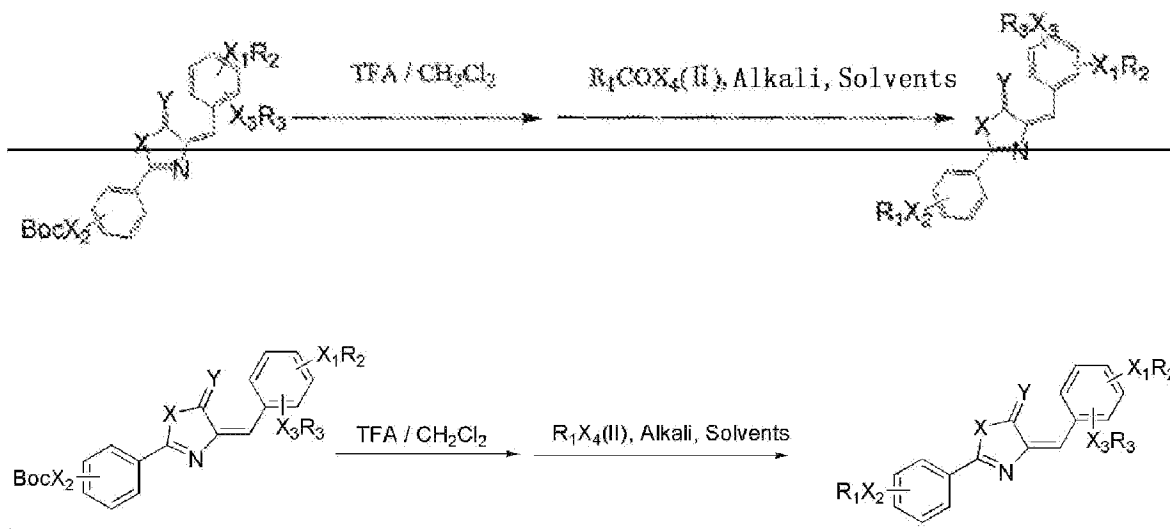
### ***Claim Objections***

8. Claims 4, 5, and 7 was objected to for using unknown characters or words such as "condensating" and a box-character. The claims were appropriately amended, thus the objection is **withdrawn**.

### **NEW REJECTIONS NECESSITATED BY AMENDMENT**

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9. The amendment filed 6/15/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: on page 9 of the substitute specification, the reactants above the second arrow differ:



Without any indication of how this new version is supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action. In addition, applicant should provide an explanation for any changes to the disclosure that is not readily obvious or the correction of a typographical error.

### ***Claim Rejections - 35 USC § 102***

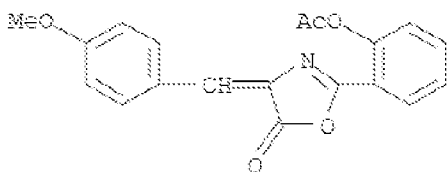
10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ibrahim, et al. (CAPLUS abstract of: Journal of Chemical Research, Synopses (2002), (2), 60-61, 243-255).

The prior art teaches the following compound which anticipates the claims when Y is O, X is O, Ar1 is substituted phenyl substituted by methoxy, Ar2 is substituted phenyl substituted by alkanoyloxy:



### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1-3, 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are ambiguous with respect to “substituents groups.” For example, Ar1 is “substituted phenyl, and the substituent groups are one, two or three groups **optionally** selected from . . .” (emphasis added). One of skill in the art would be confused by this claim language and would not know whether the substitution was required. Furthermore, the claim language uses “;” in various places in a confusing manner which does not have an apparent reason. If applicant is attempting to delineate substituent groups from substituents upon

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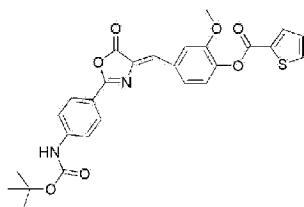
substituent groups, then the claims must make this clear in a consistent and unambiguous manner.

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 10 creates a new subgenus that does not appear to have support in the original disclosure. Claim 11 contains subject matter that does not have a basis in the original disclosure; for example, the following compound was not located in the original



disclosure:

. Applicant makes the following generic statement

regarding the support for these amendments:

continuation applications. Claims 10 and 11, depending from Claim 1, have been added.

Support for these amendments may be found, for example, in the Specification at

Paragraphs 0040 to 0067, etc. No new matter has been added, and Applicants respectfully

the examiner has reviewed these paragraphs and not found support for the new claims.

With respect to claim 10, the examiner could locate only a single compound to support



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this new subgenus, thus, there are insufficient "blazemarks" to support this new claim scope.

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim does not recite method steps in a manner that one of skill in the art would recognize how to perform the process claim. See MPEP § 2173.05(q).

18. Regarding claim 9, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Conclusion***

The claims are not in condition for allowance. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/  
Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./  
Primary Examiner, Art Unit 1626